

REMARKS

Clarification with Respect to Pending Claims and Status of Office Action

The outstanding Office Action indicates that claims 1-14 are pending. However, Applicant submits that this is in error and in fact, claims 1-6 and 8-15 are pending. For instance, Applicant refers to the Reply under 37 C.F.R. §1.116 filed on April 5, 2005. This Amendment was entered by the filing of the Request for Continued Examination on June 30, 2005. Applicant has contacted the Examiner and the Examiner has confirmed that the amendments of April 5, 2005, were in fact entered.

Also, the outstanding Office Action summary indicates that the action is both final as well as non-final (see status under items 2a and 2b). Applicant has confirmed with the Examiner that the outstanding Office Action is a non-final Office Action.

Accordingly, Applicant has deemed the Examiner's outstanding non-final Office Action to refer to claims 1-6 and 8-15. Since no amendments have been made by way of the present submission, no new matter has been added.

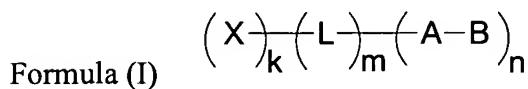
In view of the following remarks Applicant respectfully requests that the Examiner withdrawal all rejections and allow the currently pending claims.

Issues under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-14 under 35 U.S.C. §103(a) as being obvious over Ito in view of JP 11-149136 and Adin. Applicant respectfully traverses this rejection.

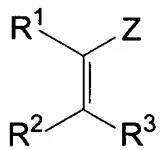
The present invention relates to a photothermographic material comprising a non-photosensitive silver salt of an organic acid, a photosensitive silver halide, a reducing agent for

silver ions and a binder on one surface of a support, which comprises at least one compound represented by the following formula (I) and at least one second compound represented by the following formula (1), (2) or (3), said second compound satisfying at least one of characteristics (i) to (iii):

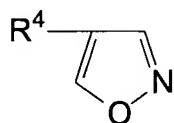


wherein, in the above formula, X represents a silver halide adsorption group or light absorption group which contains at least one atom of N, S, P, Se or Te, L represents a $(k + n)$ -valent bridging group containing at least one atom of C, N, S or O, A represents an electron-donating group, B represents a leaving group or a hydrogen atom, A-B is dissociated or deprotonated after oxidation to generate a radical A', k represents 0-3, m represents 0 or 1, and n represents 1 or 2, provided that when k = 0 and n = 1, m = 0; (i) compounds producing imagewise a chemical species that can form development initiation points on and in the vicinity of the non-photosensitive silver salt of an organic acid, (ii) compounds that provide increase of developed silver grain density to a level of 200-5000% when added in an amount of 0.01 mol/mol of silver, and (iii) compounds that provide increase of covering power to a level of 120-1000% when added in an amount of 0.01 mol/mol of silver,

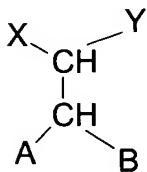
Formula (1)



Formula (2)



Formula (3)



wherein:

in the formula (1), R¹, R² and R³ each independently represents a hydrogen atom or a substituent, Z represents an electron withdrawing group, and R¹ and Z, R² and R³, R¹ and R², or R³ and Z may be combined with each other to form a ring structure, in the formula (2), R⁴ represents a substituent, and in the formula (3), X and Y each independently represent a hydrogen atom or a substituent, A and B each independently represents an alkoxy group, an alkylthio group, an alkylamino group, an aryloxy group, an arylthio group, an anilino group, a heterocyclyloxy group, a heterocyclithio group or a heterocyclamino group, and X and Y or A and B may be combined with each other to form a ring structure.

The Examiner asserts that in view of the teachings of the prior art, the presently claimed subject matter is obvious. That is, the Examiner asserts that it would have been obvious to combine the teaching of Ito (relating to the disclosure of the “second” compound Formula (1), (2) or (3)), with the teaching of JP ‘136 and Adin (related to the disclosure of the compound of formula (I)). Applicant respectfully disagrees with the Examiner. As already pointed out to the Examiner, Applicant respectfully submits that the Examiner’s rejection amounts to hindsight reconstruction. That is, Applicant respectfully submits that there exists no motivation to select specific elements from each of the respective references in order to construct the presently claimed subject matter.

At the very most, the Examiner's rejection amounts to an "obvious to try" standard, which is improper in the presentation of a *prima facie* case of obviousness. "Obvious to try" is not a valid test of patentability. In re Mercier, 185 USPQ 774 (CCPA 1975); see also Hybritech Inc. v. Monoclonal Antibodies, 231 USPQ 81 (Fed. Cir. 1986). Thus, there exists no *prima facie* case of obviousness.

Regardless, even if the Examiner has hypothetically presented a valid *prima facie* case of obviousness, a point not conceded by Applicant, Applicant submits that the unexpectedly superior properties achieved by the present invention compared to the cited art, render any hypothetical *prima facie* case of obviousness moot.

Applicant has previously submitted a Declaration executed by Tetsuo Yamaguchi on July 8, 2004. However, the Examiner has found these results to be unpersuasive. In particular, the Examiner has asserted that the properties achieved by the present invention were in fact expected in view of the combined teachings of at least Ito and JP '136. Alternatively, the Examiner has asserted that the results of the Declaration are not commensurate with the scope of the present claims. Applicant respectfully traverses and will deal with each of these aspects below.

Unexpected and Superior Properties Have Been Demonstrated

Applicant submits that the results shown in the Yamaguchi Declaration are unexpected. In particular, Applicant draws the Examiner's attention to the results in the Declaration with respect to "sensitivity". For instance, sample A-2 which utilizes only a compound according to formula 95 of JP '136 (compound of formula (I)) achieves a sensitivity of 0.75. Sample A-3, which utilizes only compound C-1 of Ito '084 (corresponding to compound of formula (1) of the

present invention) achieves a sensitivity of 1.00. Accordingly, if the results were simply expected, one might only expect a very small increase in sensitivity compared to the results in sample A-3. However, a review of samples A4, A6, A8 and A10, reveal an increase in sensitivity up to 1.25, 1.20, 1.20 and 1.20, respectively. This represents a marked increase when the two compounds according to the present invention are both utilized.

This increase is greater than would be expected from either the combination or the independent use of each compound. For instance, the baseline sensitivity for sample A-1, wherein neither compound is utilized, is 0.7. Sample A-2 shows an increase of 0.05 to a total of 0.75 (sensitivity) when only the compound 95 of JP '136 is utilized. Sample A-3 shows a 0.30 increase when only compound C-1 of Ito '084 is utilized. However, as shown in sample A-4 when both compound C-1 of Ito '084 and compound 95 of JP '136 are utilized, a sensitivity of 1.25 results. This represents a 0.55 increase compared to the baseline sample A-1. Similar results are shown for the other compounds tested in the Declaration. Thus, such results, even if hypothetically expected to increase slightly are much higher than would be expected and therefore are unexpected. Accordingly, the Examiner is incorrect in asserting that the results according to the Declaration are unexpected for the above reasons.

The Results are Commensurate in Scope

Applicant disagrees with the Examiner's assertion that the Declaration is not commensurate in scope with the present claims. The Examiner has asserted that the Declaration only provides results for the compound (second compound) of formula (1). This is incorrect. Although compound C-1 and C-42 fall within the scope of formula (1), Applicant draws the

Examiner's attention to the fact that compound C-8 falls within the scope of formula (2) and compound C-57 falls within the scope of formula (3). Accordingly, Applicant respectfully submits that the Declaration provides results which are commensurate in scope with the present claims.

In view of the above, Applicant respectfully submits that the unexpectedly superior results according to the present invention render any hypothetical *prima facie* obviousness moot. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Obviousness-Type Double Patenting

The Examiner has rejected claims 1-14¹ under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-20 of U.S. Patent No. 6,764,816 in view of Ito. Applicant respectfully traverses this rejection. The Examiner asserts that it would have been obvious to the worker of skill in the art at the time the invention was made to use the nucleating agent taught in Ito to improve the image contrast of the material claimed in U.S. 6,764,816. Applicant submits that the Ito reference has been distinguished above. Accordingly, this rejection is improper and should be withdrawn.

In view of the above, Applicant respectfully submits the present claims define allowable subject matter. Accordingly, the Examiner is respectfully submitted to withdrawal all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

¹ Properly claims 1-6 and 8-15 are pending.

Application No. 10/046,141
Amendment dated February 9, 2006
Reply to Office Action of August 9, 2005

Docket No.: 2870-0177P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: February 9, 2006

Respectfully submitted,

By  A42-874

Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant